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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005.428	12/03/2001	Stephen M. Key	PA2321	1741
22830	7590	12/21/2005		
CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303			EXAMINER ZIRKER, DANIEL R	
			ART UNIT 1771	PAPER NUMBER
DATE MAILED: 12/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/005,428	KEY, STEPHEN M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Daniel Zirker	1771	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-26, 32-35, 41, 46, 47, 50, 51 and 53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32-35 and 53 is/are allowed.
- 6) ☒ Claim(s) 24-26, 41, 46, 47, 50 and 51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1771

1. Upon review of the conditions for allowance it was discovered that during prosecution too much emphasis was placed on the function of the claimed device rather than on exactly how the claimed device is constructed. In light of this reconsideration, prior art was discovered that renders the structure of the claimed device unpatentable. As such, the indication of allowability is withdrawn in favor of the grounds of rejection set forth below.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 24-26, 41, 46-47, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez, US 5,712,021 in view the state of the art as evidenced by Hanson, US 2,069,609.

It should be noted that claims 24 and 46 do not actually call for a container. These claims merely call for a system for providing a label about a container. The container is not positively recited. Hernandez provides a system for providing a label about a container comprising an outer label 1 with a leading edge 4, trailing edge 5, front surface and back surface (see generally Figs. 1-3), a temporary adhesive 7 temporarily coupling the outer label to a container 6, and a permanent adhesive 4 disposed adjacent the trailing edge and securing the back surface of the trailing edge to the front surface of the label. The patent teaches that the bond formed by the temporary adhesive may be broken to allow removal of the label from the container. While Hernandez is silent as to rotation of the label, it should be apparent that if the label can be removed, it can also be rotated once the adhesive is broken, thus facilitating the claimed functional language "allowing the secured outer label to rotate about the container" (note column 2, lines 45-61). Lacking from Hernandez is a teaching of a transparent region.

However, the provision of a transparent region in a labeled container is old and well-known to the art as illustrated and evidenced by Hanson which on page 2, lines 25-30 sets forth that by proper selection of colors and transparent areas, it is possible to produce marvelous aesthetic effects and to even create pronounced perspective effects upon representations of objects.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to provide the label of Hernandez with transparent regions motivated by the expectation of increasing the aesthetic affect of the Hernandez label. It is recognized that Applicant's reasons for providing transparent regions is not the same as those of the prior art. However, the functionality desired by Applicant is not realized nor required in the structure of the rejected claims.

Since claims 24 and 46 do not positively recite a container, the limitations of claims 25, 50 and 51 are not limiting to the claimed device since they modify the container, or in the case of 51 modify the inner label which also is not required to be present; the Examiner does note, however that 35 USC 112 2<sup>nd</sup> paragraph issues may be present since it appears that one of these two elements must be present in independent claim 46. Additionally, the presence of a temporary hot cement as the temporary adhesive of claim 41 is believed to be a well known adhesive composition to one of ordinary skill. As such, claims 25, 41, 50 and 51 are rendered unpatentable over the applied art.

Hernandez does not specify the properties of the adhesives employed beyond specifying temporary and permanent. As such, it is necessary for one practicing the invention of Hernandez to look to the prior art for suitable adhesives. As admitted by Applicant in the instant

Art Unit: 1771

specification, such adhesives as, e.g. temporary hot cements are commercially available. As such, it would have been obvious to one of ordinary skill in the art to select a suitable, commercially available, adhesive based on its suitability for the intended use, including the adhesives instantly claimed; note *In re Leshin*, 125 USPQ 416.

In the final product, whether the first adhesive is placed on the container or the label becomes irrelevant since it bonds the two together and the original placement distinction is lost.

4. Claims 32 – 36 and 53 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terrel H. Morris whose telephone number is 571-272-1478. The examiner can normally be reached on Monday - Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571 – 272 - 1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/005,428

Page 5

Art Unit: 1771

Daniel Zirker  
Primary Examiner  
Art Unit 1771

A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive style with a large, stylized 'Z'.